REMARKS

Claims 1-13 and 37-38 are pending in this application, and claims 15-36 have been withdrawn.

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

I. RESTRICTION REQUIREMENT

Applicants again assert that the examiner has failed to satisfy his burden with respect to dividing the claims of Groups I and II into separate applications. According to the examiner, the "Restriction Requirement . . . indicated that the inventions recognized divergent subject matter and that a different field of search would be required based upon the structurally distinct products recited and the various methods of use comprising distinct method steps." Office Action, pg. 2, 2nd ¶. This assertion is factually erroneous, however.

As a matter of fact, the examiner provides no evidence that the inventions encompassed by the claims of Groups I and II are distinct. Furthermore, the examiner has failed to prove that examination would be seriously burdensome by showing either a separate classification of the inventions, a separate status in the art when the inventions are classifiable together or the necessity of a different field search. MPEP § 808.2. Accordingly, applicants renew their request that the restriction be withdrawn.

II. REJECTIONS UNDER 35 U.S.C. § 102

The examiner rejects claims 1, 7, 8 and 37 under 35 U.S.C. §102(e) as allegedly being anticipated by Schulman (WO 02/12448) and Nilsson (WO 01/85096). Applicants respectfully traverse the rejection.

As an initial matter, applicants note the examiner relies upon an out-dated form of 35 U.S.C. §102(e). In any event, for the examiner to reject the claims for anticipation, he must demonstrate that each claim limitation is contained in a single reference. *See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). Applicants assert that the examiner has failed to satisfy this burden.

In particular, the examiner has failed to identify within Schulman the claim limitation of step d), *i.e.* identifying a subset of compounds that are unable to promote significant death of a cell chosen from other hematopoeitic cells that are not mast cells or related cells or cell lines or derived cell lines thereof, such as SCF independent expanded human normal CD34+ cells. Likewise, the examiner has not shown that Nilsson teaches this limitation or the limitation recited in step b), *i.e.* adding to the culture medium at least one candidate compound to be tested and incubating the cells for a prolonged period of time. Thus, as a matter of law, neither Schulman or Nilsson can anticipate the claimed invention.

Accordingly, the rejection should be withdrawn.

III. REJECTIONS UNDER 35 U.S.C. § 103

The examiner rejects claims 3-6 and 9-12 under 35 U.S.C. §103(a) for allegedly being unpatentable over Schulman or Nilsson in view of ATCC Catalog Nos: TIB-64; CRL-2034; CRL-2036; CRL-2037; TIB-152; CCL-213; CRL-1593.2; CCL-240; CRL-2258; and CRL-2392. The examiner also rejects claim 13 under 35 U.S.C. §103(a) for allegedly being unpatentable over Schulman or Nilsson in view of Longeley (US 6,339,100). Applicants respectfully traverse the rejection.

In levying an obviousness rejection under 35 U.S.C. 103, the examiner has the burden of establishing (1) some suggestion or motivation to modify the reference or to combine reference teachings, (2) a reasonable expectation of success, and (3) that the prior art references, when combined, teach or suggest all the claim limitations. *See* MPEP §2143 (May 2004). "Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438 (Fed. Cir. 1991).

As noted above, Schulman and Nilsson lack one or more elements of the claimed invention. Neither the referenced ATCC cell lines nor Longeley, which discloses methods and compounds for treating mastocyosis, cures the deficiencies of the primary references. Thus, no combination of the cited references contains all the elements of the claimed invention.

Applicants, therefore, request that the rejection be withdrawn.

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Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

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